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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 08/673,642 | 06/25/96 | ROSE | 6253 |

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MM51/0529

EXAMINER

LE, T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2876 | |

RECEIVED

JUN 01 1998

DATE MAILED:

05/29/98

LAW DEPARTMENT

Response due August 29, 1998.

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/673,642

Applicant(s)
Rose

Examiner
Thien Le

Group Art Unit
2876



☒ Responsive to communication(s) filed on Mar 9, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 and 3-18 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 6 and 7 is/are allowed.

☒ Claim(s) 1, 3, 5, and 8-11 is/are rejected.

☒ Claim(s) 4 and 12-18 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The amendment filed on 3/9/98 has been entered. Claims 1 and 3-18 remain for examination.

Claim Objections

2. Claim objected to because of the following informalities. Appropriate correction is required.

Claim 4 depends on canceled claim 2. It should be changed to depend on claim 1.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-5, drawn to the apparatus and method claim 8-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Ziarno [5,663,547].

Regarding claim 1, Ziarno discloses a portable unit 100 having a card reader 307. The portable unit communicate with a terminal 120 via wireless communication link such as RF, infrared, etc. The use of a wireless modem is considered inherent in light of the use of a wireless

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communication link. The reader 307 contains 10-15 keys, a display for prompting users in the manner as recited in the claimed manner. The difference is that Ziarno fails to disclose the use of a printer for printing receipt and wireless modem. Since Ziarno is interest in keeping of donations for tax filing purposes, it would have been obvious to incorporate a printer for printing receipts. In this case, the receipts can be used for additional record keeping purposes. Regarding the wireless modem, Ziarno's wireless communication line requires either a transceiver or a modem for transferring data. Although Ziarno does not specifically recites a modem, it would have been obvious to use a wireless modem in his system. The use of a wireless modem is not new. U.S. Pat. Nos. 5,729,542; 5,689,547; 5,682,605; D374,675; 4,759,078 are cited as evidence showing the conventionality of the use of wireless modems in transferring data. Thus, using a wireless modem in Ziarno's wireless communication link is merely a logical design consideration which is not considered novel.

Regarding claim 3, since there will be more than one units to be used, the use of identification codes to identify each unit is necessary to maintain proper operation.

Regarding claim 5, see the discussions regarding claim 1.

Regarding claim 8, see the discussions regarding claim 1.

Regarding claim 9, see the discussions regarding 1. Further, Ziarno is using a typical credit card reader which inherently includes a statement indicating that the transmission has been successfully conducted.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Ziarno [cited above].

Regarding claim 10, see the discussions regarding claim 1. Further, Ziarno's system includes instructions for guiding a user which would meet all limitations set forth in this claim. The phrase "enabling a person who has never seen said device previously to execute a credit card transaction" is clearly subjective which should be met by the user friendly features and display prompts of Ziarno's system.

Allowable Subject Matter

7. Claims 4, 6-7 and 12-18 are allowed.

8. The following is an examiner's statement of reasons for allowance: The prior art discloses the claimed means for illuminating light having the characteristics as recited in claim 4. The prior art fails to disclose a transaction unit having the means for preventing one from changing the

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entered transaction [billing] amount in the manner as recited in claim 6. The prior art also fails to disclose the claimed method of disabling the wireless modem, the alternate messages, etc. as recited in claims 12-18.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Applicant's arguments filed on 3/9/98 have been fully considered but are not persuasive. In response to applicant amendments and response, the examiner has further cited references showing the conventionality of the claimed matter.

Regarding claims 1, 3, 5, 8-9, 11, reference to Ziarno includes the use of a wireless credit card reader, display prompts, keypad having 10-15 keys, etc. Although Ziarno is silent about the use of the wireless modem, it would have been logical to use a wireless modem for Ziarno's wireless system. References and motivations are provided showing the conventionality of the wireless modems in data communication. In response to applicant's arguments, the examiner submits that not every wireless communication link is a cellular communication link. Wireless adapters have been use widely in military applications since 1940s to prevent jamming, eavesdropping, and signal interferences. Spread spectrum and other accessing techniques have

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been used far before “cellular” concepts come into the screen. Although Ziarno is silent about the use of a wireless modem, it would have been obvious to do so [see the discussions above]. There is no requirement that a reference must show any evidence of record that the prior art which suggests the combinations. In re Sernaker, In re Deminski, etc. It is respectfully submitted that the requirement for 103 obviousness rejection is that the invention was made by applying the knowledge clearly presented in the prior art. It further is not necessary that the reference (or references) actually suggests, expressly or in so many words, changes or possible improvements (see In re Scheckler, 58 CCPA 936, 168 USPQ 716). It is noted that the examiner has carefully provided a parallel structure for making the comparison between the claimed elements to corresponding elements of Ziarno and others. The underlying inventiveness concepts of applicant’s claimed invention is a wireless capability of performing a credit transaction, so does Ziarno. Therefore, the 103 obviousness rejection is hindsight. In light of applicant’s argument, the examiner further submits that there is no requirement that a motivation to make the modification be expressly articulated. The test for combining the references is what the combination of disclosures taken as a whole would suggest to a routineer in the art (see In re McLaughlin, 170 USPQ 209). Therefore, one can not show non-obviousness by attacking the references individually where, the rejections are based on combination of references.

For the reasons stated above, the examiner firmly believes that the 103 obviousness rejection is a proper prima-facie case of rejection and is not a hindsight analysis by reading into the prior art the additional contributions of the applicant’s teachings as asserted by applicant.

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Claim 10 is "unduly" broad, the nature of Ziarno credit card device and the use of a wireless modem to transfer data would meet all claimed limitation. The phrase "enabling ---- never seen ----" is clearly subjective which does not place any structural and functional limitations in the claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien Le whose telephone number is (703) 305-3500. The examiner can normally be reached on Monday to Friday from 8:30 am to 4:30 pm.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**don.hajec@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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A handwritten signature in black ink, appearing to read 'Thien Le', with a stylized, cursive script.

Thien Le
Art Unit 2514
April 27, 1998